

Application No. 10/766,939  
Reply to Office Action dated May 16, 2006

Attorney Docket No. FS-F03228-01

## **REMARKS**

### **I. Amendment**

By the present Amendment, claim 1 is amended by incorporating the subject matter recited in claim 8, and claim 8 is cancelled. Claim 13 is amended so as to depend from claim 12.

No new matter has been added.

### **II. Rejection under 35 U.S.C. § 112**

Claim 13 has been rejected under 35 U.S.C. § 112 due to insufficient antecedent basis for the word, "the laser". Claim 13 is amended so as to depend from claim 12, making this rejection moot.

### **III. Rejection under 35 U.S.C. § 102(b) and/or 103(a)**

On page 3 of the Office Action, in paragraph 7, claims 1-4 have been rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Okada et al. (USP 6,120,983, hereinafter "Okada").

On page 4 of the Office Action, in paragraph 8, claims 1-7, 9-12 and 15-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Okada and Siga et al. (USP 4,332,889, hereinafter "Siga").

On page 6 of the Office Action, in paragraph 9, claims 8, 14, 25 and 26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Okada, Siga and further in view of Toya et al. (USP 5,656,419, hereinafter "Toya").

With the present Amendment, claim 1 is amended by incorporating the limitation of a polyhalomethane compound recited in claim 8. Okada does not teach or suggest the polyhalomethane compound, and the novelty of the amended claim is well established with the present amendment.

In response to obviousness rejection, a declaration under 37 C.F.R. § 1.132 is submitted herewith. The content of the declaration will be detailed in the next section.

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**IV. Declaration under 37 C.F.R. § 1.132 and Response to the Examiner's argument**

Additional experimental data is herewith submitted in a form of declaration under 37 C.F.R. § 1.132. Unexpectedly superior results are shown in the declaration in terms of unprocessed (raw) storability. The declaration is commensurate with the scope of amended claim 1, and supplemented with additional test results in response to Examiner's argument. Unobviousness of the present invention over Okada, Siga, Toya, or any combination thereof is well established with the declaration.

The Examiner has argued in his Office Action that the declaration is insufficient in several aspects. Applicant respectfully responds to each of his arguments as follows.

(1) On page 9, lines 3-7 of the Office Action, it is argued that the declaration is insufficient to overcome the prima facie case of obviousness rejection because one of skilled in the art would expect that the material containing high silver iodide content would result in raw stability of the raw image forming material such as taught in Siga.

Applicant respectfully traverses. The experimental results attached hereto show unexpectedly superior results in terms of unprocessed (raw) storability when high silver iodide content and the specific adsorbable redox compound recited in claim 1 are employed in combination. The results are unexpectedly superior compared to the results obtained by the single use of either high silver iodide content or an adsorbable redox compound. Those results exhibited by the declaration is neither taught nor suggested by Siga.

(2) On page 9, lines 7-11 of the Office Action, it is argued that the declaration fails to disclose the type of radiation used in the imagewise exposure or the temperature using in the heating steps. Attention should be drawn to the declaration submitted on March 20, 2006, page 2, lines 13-15. It is clearly stated, "Thermal development and evaluation of raw storability were carried out under the same conditions as in Example 1 of the present application, except in that the light exposure times were changed as shown in the following table." Specifically, the type of radiation used in the imagewise exposure and the temperature in the heating steps are disclosed on page 196 of the present specification.

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(3) On page 9, lines 11-16 of the Office Action, it is argued that the results are not commensurate with the scope of the claimed invention as the declaration shows only the thermal development time of 12 seconds while the claimed scope of developing time is 1 to 12 seconds.

New experimental data is added to the 37 C.F.R. § 1.132 declaration attached hereto for the development time of 5 seconds and 10 seconds, which would complement the whole claimed scope.

Incidentally, the experiment employs a polyhalomethane compound as explained in Example 1 of the present specification while amended claim 1 contains the limitation of polyhalomethane compounds represented by formula (H). The declaration is commensurate with the claimed scope in this respect. Inclusion of a polyhalomethane compound enables to obtain a proper photographic characteristic curve.

(4) On page 9, lines 16-21 of the Office Action, it is argued to be unclear as to what degree the unexpected results are in the declaration. It is also stated that the difference between the inventive results and the comparative results are found to be relatively small, between 3-5% which is within an error range.

The experimental data submitted herewith as a 37 C.F.R. § 1.132 declaration includes data in which sensitivity is calculated at a density of fog density + 3.0, which is on the shoulder of photographic characteristic curve. In this manner, the superior property of the present invention in terms of unprocessed storability is exhibited more clearly.

(5) On page 9, line 21-page 10, line 1 of the Office Action, it is argued that the data is not reasonably commensurate in scope with the claims which are broad in scope and cover mixtures of numerous untested compounds.

In response, the declaration submitted herewith covers additional compounds, and is commensurate in scope with the claim. Specifically, the adsorbable redox compounds used in the experiment encompass every reducing group of Formulas B<sub>1</sub> to B<sub>5</sub> and Formula B<sub>13</sub> as recited in claim 1.

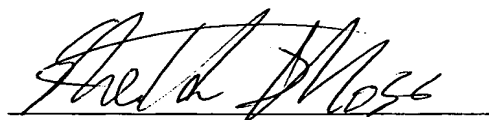
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**V. Conclusion**

In view of the foregoing amendments and remarks, it is submitted that all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Sheldon J. Moss", is written over a horizontal line.

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